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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/438,944	11/12/99	STEWART	M T57005US

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EXAMINER

DECLoux, A

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 01/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/438,944

Applicant(s)

Stewart, M. et al.

Examiner

DeCloux, Amy

Group Art Unit

1644



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-28 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-28 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-11, and 22-24 drawn to a composition for inducing thrombus formation and a kit, classified in Class 424, subclass 184.1,

II. Claims 12-24, drawn to a method for inducing thrombus formation in vivo, classified in Class 435, subclasses 69.7, 174 and 975.

III. Claims 25-26, drawn to a method of treating cancer or an undesirable condition, classified in Class 424, subclasses 277.1 and 278.1,

IV. Claim 28, drawn to a method of inducing thrombus formation in vitro, classified in Class 435, subclass 7.21.

2. Inventions II-IV are different methods. Inventions II/V and III and IV differ from each other with respect to their endpoints. Inventions II and V have similar endpoints but differ in their process steps. Therefore, Inventions II-V are patentably distinct each from the other.

3. Groups I and II-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the composition for inducing thrombus formation, can be used to isolate proteins involved in the clotting process.

4. Because Inventions I-IV are distinct for the reasons given above, and they have acquired a separate status in the art because the searches of the non-patent literature are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

5. If Invention I is elected, the applicant is further required under 35 U.S.C. 121,

A) To elect a composition with a **specific type of first binding component**, such as one of the components recited in claim 3, which include an antibody-type component, a peptide or protein, a nucleic acid sequence or oligo, and a specific ligand,

B) To elect a composition with a **specific second binding component**, such as one of the components recited in claim 5 and claim 22,

C) To elect a composition with a **specific platelet binding enhancer**, such as one of the components recited in claim 7,

D) To elect a composition with a **specific thrombus formation modulator**, such as one of the components recited in claim 9.

6. If Invention II is elected, the applicant is further required

A) To elect a method comprising a **specific targeting agent** such as one of the agents recited in claim 14, which include an antibody type agent, a peptide or protein, a nucleic acid sequence or oligo, and a specific ligand,

I) if a bifunctional agent is elected in part 6A, then applicant is further required to elect a method comprising a **specific platelet-specific component** such as one of the components recited in claim 17,

7. Applicant is required, in response to this action, to elect a specific species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

10. The following claim(s) are generic: claims 1, 2, 6, 8, , 12, 13, 16, and 20, for example.

11. The species are distinct each from the other because the methods of Group II comprise steps using different products. The products of Groups I and II differ with respect to their physicochemical properties and are therefore patentably distinct.

12. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

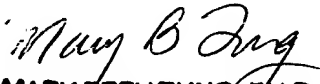
13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

14. A telephone call to request an oral election was not made due to the complexity of the restriction

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Amy DeCloux, Ph.D.
Patent Examiner
Group 1640
Technology Center 1600
January 16, 2001


MARY BETH TUNG, PH.D.
PATENT EXAMINER